

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

In this amendment, claims 2-6, 13, 15, and 26-68 are canceled. Further, claim 1 has been amended to further clarify the claim. Support for this amendment can be found in claims 3-5, 14, and 16 of the application, the examples, and, for instance, at paragraphs [0017] - [0023] of the present application.

Furthermore, claim 69 has been added which recites the language of claim 1 and further additional language, which can be found, for instance, at paragraph [0022]. Accordingly, no questions of new matter should arise and entry of this amendment is respectfully requested.

Rejection of Claims 1, 3-5, and 7-25 under 35 U.S.C. §112, second paragraph

Claims 1, 3-5, and 7-25 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

In response, claims 3-5, 13, and 15 are canceled. Claim 1 no longer uses the word "creating." Further, the previous wording and the present wording would be clear to one skilled in the art, which is the standard under 35 U.S.C. §112, second paragraph, as well as in M.P.E.P. §2173.04

Further, the term "specifying" recited in claim 7 concerns specifying morphological values and has definite meaning when properly read in light of the present specification, for example, as in paragraphs [0033] - [0036]. When read in view of the present specification, the term "specifying," recited in claim 7 is clearly not a mental step and recites the step of actually specifying (e.g.,

determining) the morphological value, and the present application at paragraphs [0033] - [0034] provide the physical steps that can be used to achieve this "specifying." Claim 7 sets forth what applicants regard as their invention with a reasonable degree of precision and particularity, and satisfies the requirements of 35 U.S.C. §112, second paragraph.

Claim 8 further specifies the "specifying" step of claim 7, and clearly recites a method step. Claim 8 recites that this step comprises "including the morphological value on a product specification sheet. . ." (emphasis added). In the final Office Action, at page 3, the Examiner asked the question whether claim 8 is claiming the recordation of product specifications on a sheet. In response, first, claim 8 must be read in context with claim 7 and then claim 1, which involves a method for identifying a product specification. The product specification as recited in claim 8 requires measuring at least one interfacial potential property value and then at least one morphological value and including these determinations on a product specification sheet. The scope and definiteness of this claim is quite clear, and the Examiner has provided no other reasoning for the rejection of this claim other than the question raised by the Examiner, which has been addressed. Therefore, claim 8 sets forth what Applicants regard as their invention with a reasonable degree of precision and particularity, and satisfies the requirements of 35 U.S.C. §112, second paragraph.

Claim 9 is dependent on claim 8, and specifies the morphological value (i.e., surface area, particle size, structure, porosity, etc.) that is included on a product specification sheet. Since claim 9 is dependent on claim 8 and specifies particular morphological values, the arguments presented above regarding the patentability of claim 8 in view of 35 U.S.C. §112, second paragraph, apply equally here. Claim 9 provides examples of particular morphological values, which are understood by those skilled in the art since these are common morphological values as explained in the present

application. For instance, paragraphs [0033] and [0034] provide specific examples of morphological properties and tests used, as well as ASTM techniques. Claim 9 sets forth what Applicants regard as their invention with a reasonable degree of precision and particularity, and satisfies the requirements of 35 U.S.C. §112, second paragraph.

The term "specifying" recited in claim 10 concerns chemical values and has definite meaning when properly read in light of the present specification, such as in paragraphs [0035] - [0036], and reference is made thereto. Claim 10 has a very similar approach to claim 7, except in claim 10, a chemical value is specified as opposed to a morphological value. The same arguments as set forth above with respect to the patentability of claim 7 in view of 35 U.S.C. §112, second paragraph, apply equally here. The term "specifying," recited in claim 10 is clearly not a mental step. Claim 10 recites the step of actually specifying (e.g., determining) the chemical value and the present application, at paragraphs [0035] and [0036], provide the physical steps that can be used to achieve this "specifying." Therefore, claim 10 sets forth what Applicants regard as their invention with a reasonable degree of precision and particularity, and satisfies the requirements of 35 U.S.C. §112, second paragraph.

Claim 11 further specifies the "specifying" step of claim 10, and clearly recites a method step. Claim 11 recites that this step comprises "including the chemical value on a product specification sheet. . ." (emphasis added). Claim 11 takes a similar approach as claim 8, except a chemical value is further included in the product specification sheet, instead of a morphological value as recited in claim 8. For the same reasons, as set forth above with respect to claim 8, this claim would also be patentable under 35 U.S.C. §112, second paragraph. In the final Office Action, at page 3, the Examiner asked the question whether claim 11 is claiming the recordation of product specifications on a sheet. In response, first, claim 11 must be read in context with

claim 10 and then claim 1, which involves a method for identifying a product specification. The product specification as recited in claim 11 requires measuring at least one interfacial potential property value and then one chemical value to include on a product specification sheet. The scope and definiteness of this claim is quite clear, and the Examiner has provided no other reasoning for the rejection of this claim other than the question raised by the Examiner, which has been addressed. Therefore, claim 11 sets forth what Applicants regard as their invention with a reasonable degree of precision and particularity, and satisfies the requirements of 35 U.S.C. §112, second paragraph.

Accordingly, this rejection should be withdrawn.

Rejection of claims 1, 3-5, and 7-25 under 35 U.S.C. §102(e) -- Mansky

Claims 1, 3-5, and 7-25 were finally rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0097871 A1 to Mansky (hereinafter "Mansky").

According to the Final Office Action dated November 5, 2007 (page 3), and the Office Action dated February 9, 2007 (page 7), the Examiner appears to interpret the present invention as "a method of tagging with a particle that has identifiable characteristics." (See, Office Action dated February 9, 2007, page 7). The Examiner then asserts that Mansky teaches in paragraph [0016] using a tag to identify a pellet that reads on the claimed method for creating a product specification. This rejection is respectfully traversed.

The present invention does not relate to any "method of tagging" with a particle that may or may not be shown in Mansky. Mansky is not at all relevant to the subject matter of the claimed invention. Furthermore, the Examiner does not cite any portion of Mansky, beyond paragraph [0016], to support a position of anticipation.

As recited in claim 1, the present invention is directed to a method for identifying a product specification for a batch, lot, or shipment of particulate material which involves measuring an interfacial potential property value for the batch, lot, or shipment of particulate material. The interfacial potential property value can be included on a product specification sheet for the brand or grade of particulate material. The present invention is useful in resolving a serious problem associated with particulate material production in which particulate materials that are seemingly made "within spec" with respect to one or more measures of morphology, such as particles size, surface area, structure, porosity, etc., nonetheless do not perform consistently as expected in customer applications. The method of the present invention involves the step of measuring at least one interfacial potential property value to the lot, batch, sample, and/or shipment of particulate material to help insure that customers receive particulate materials that not only are "within spec" relative to morphological properties and the like, but which also will perform consistently and reliably in applications. Oftentimes, a customer and/or a supplier will agree on specifications for a unit of product that may be included in a contractual agreement, purchase order, invoice, contract, waiver to a contract, or combinations thereof. In various embodiments of the present invention, the product specification that includes at least one interfacial potential property value also can be included as part of such materials. Mansky does not teach any method for creating a product specification having the combination of features as recited in claim 1.

To further assist the Examiner, the Examiner is directed to Example 2 of the present application, which provides one example of the immense benefits provided by the present invention. As shown in Example 2, using previously known ways to specify carbon black, the "same grade of carbon black" from four manufacturing plants was analyzed with respect to conventional morphological values. In particular, a DBP value was measured for the four samples

and it was noted that, each case, the morphological value was essentially the same and, therefore, in the past, would have been considered "the same grade of carbon black" using conventional criteria for creating carbon black. However, when each of these carbon blacks were measured to determine a particular interfacial potential property value, the interfacial potential property value was different from carbon black to carbon black from each plant. Thus, based on this additional criteria, the four samples were not the same, and technically are not the same grade of carbon black. The present invention essentially takes the specification of particulate material, such as carbon black, to a new higher level of specification and accuracy, which did not exist prior to the present invention. As explained further below, Mansky is entirely irrelevant to this process of identifying a product specification and merely relates to physically tagging materials for screening purposes. The product specification used in the present claims is not taught or even suggested in Mansky and, actually, Mansky uses conventional properties to simply screen the particulates.

In more detail, Mansky describes a method for screening an array of materials for mechanical properties such as surface tension or interfacial tension. According to paragraph [0016] of Mansky, support beads or pellets are coated with component(s) of interest, wherein the bead or pellet can be identified with a tag, such as an etched binary bar code used to indicate the history of the bead or pellet, i.e., to identify which components were deposited thereon. In contrast to the presently claimed invention, Mansky does not teach any method for identifying a product specification for a batch, lot, or shipment of particulate material comprising measuring at least one interfacial potential property value for the batch, lot, or shipment of particulate material. Instead, Mansky etches a code on a bead or pellet, which indicates the history of components that have been deposited on the bead or pellet. Mansky's etched bead methodology does not address or solve the

problem of particulate materials that appear to be "within spec" but do not perform consistently in end-use applications, as provided by the present invention.

In view of the many differences that exist between Mansky and the present claims, Mansky fails to identically disclose the features of the claims. In the absence of an identical disclosure, Mansky can not anticipate the claims.

For these reasons, this rejection should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 03-0060. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



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